

REMARKS

The final rejection dated December 11, 2009 has been carefully reviewed and the foregoing amendments and following remarks are made in response thereto.

Claims 22-40 were pending in the application at the time the final rejection dated December 11, 2009 was issued. Claim 38 has been amended to specify that the isolated polynucleotide comprises a 180-mer, a 220-mer, a 250-mer, a 300-mer, a 400-mer, a 500-mer or a 600-mer complementary to the sequence of SEQ ID NO: 12, SEQ ID NO: 60, or nucleotides 1-1643 of SEQ ID NO: 113. Support for this amendment can be found in the specification at page 12, line 24 to page 13, line 5. No new matter has been added by way of these amendments.

Applicants acknowledge the Examiner's withdrawal of the previous objection to the specification, and the previous rejections of claims 22-37 under 35 U.S.C. § 112, 1st paragraph, of claims 23 and 25-37 under 35 U.S.C. §112, 2nd paragraph and of claim 39 under 35 U.S.C. §102.

I. Rejection under 35 U.S.C. §112, 1st paragraph**Lack of enablement**

Claims 38 and 40 are rejected under 35 U.S.C. §112, 1st paragraph for allegedly lacking enablement. The Examiner maintains her position that the specification does not disclose fragments of SEQ ID NO: 12, SEQ ID NO: 60 or nucleotides 1-1643 of SEQ ID NO: 113 as short as 20-mers which possess promoter activity. The Examiner further maintains her argument that one of skill in the art would not know how to use fragments of a promoter except as part of a functional promoter sequence and the skilled artisan would have to engage in undue experimentation to use such fragments. Applicants respectfully maintain their disagreement with the Examiner and traverse the rejection. Applicants submit that the claims are enabled for any fragments of the claimed sequences.

Applicants have amended claim 38 so that the fragments are in the range of a 180-mer to a 600-mer which is a similar range as claimed in claim 39 which is not rejected for lack of enablement by the Examiner. Applicants maintain their position that the 20-mer to 150-mer fragments of previous claim 38 do not require functional promoter activity but that are complementary to SEQ ID NO: 12, SEQ ID NO: 60, or nucleotides 1-1643 of SEQ ID NO: 113.

But in an effort to expedite prosecution, Applicants have amended claim 38 so that the fragments are larger in size. Applicants submit that this claim amendment should overcome this rejection. Therefore, in view of this amendment directed to longer fragments that are complementary to the claimed sequences, Applicants respectfully request that the rejection of claim 38 and its dependent claim 40 under 35 U.S.C. §112, 1st paragraph be withdrawn.

II. Obviousness-type Double Patenting

Claims 22-40 remain rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,365,186 ("the '186 patent).

Applicants again submit that this double patenting rejections is improper for the reasons set forth previously. However, Applicants would consider filing a terminal disclaimer once all of the claims in this application are considered to be allowable by the Examiner but for the obviousness-type double patenting asserted against pending claims 22-40. Therefore, until the pending claims are not rejected on any other grounds but the obviousness-type double patenting rejection, Applicants request that this rejection be held in abeyance at this time.

CONCLUSION

This reply is fully responsive to the Office Action dated December 11, 2009. In view of the above amendments and remarks, it is believed that the present set of claims are now in condition for allowance. If, in the opinion of the Examiner, a further telephonic conference would expedite any minor issues with regard to the pending claims, the Examiner is invited to call the undersigned practitioner.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-1283.

Respectfully submitted,
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